



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re application of:)	Group Art Unit: 3712
Peter F. Titus)	Examiner: Fernstrom, Kurt
Serial No.: 10/611,705)	Attorney Docket: PT 03153
Filed: July 1, 2003)	Date: January 11, 2005

For: WORD KEY

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ALEXANDRIA, VA 22313-1450

TRANSMITTAL LETTER

Sir:

On November 11, 2004, the undersigned agent for Appellant filed a Notice of Appeal from the Examiners rejection of claims 1-20 dated June 16, 2004. It is applicant's intention to contest the rejection of claims 1-20.

Enclosed, herewith, is an Appeal Brief (in triplicate) as required by 37 CFR 1.192 and Credit Card payment form PTO-2038 in the amount of \$250.00 to cover the Small Entity Fee for filing a Brief in support of an Appeal.

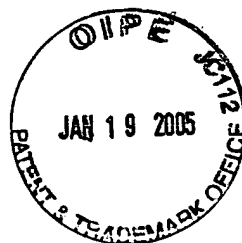
Respectfully submitted,

By: *Amos Bartoli*
Amos Bartoli
Agent for Appellant
Registration No. 42,299

JAMES RAY & ASSOCIATES
2640 PITCAIRN ROAD
MONROEVILLE, PA 15146

TELEPHONE: 412-380-0725
FACSIMILE: 412-380-0748

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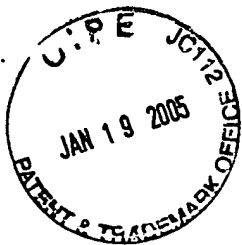
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on

January 11, 2005

Suzette O'Leary



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COMMISSIONER OF PATENTS
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Sir:

The following appeal brief for Appellant under Rule 1.192 is submitted pursuant to the Notice of Appeal filed November 11, 2004 in the above-identified application.

(1) Real Party in Interest

The real party in interest of the present application is Peter F. Titus.

(2) Related Appeals and Interferences

There are no appeals or interferences pending which directly affect this application.

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(3) Status of Claims

Claims 1-20 are currently pending in the application according to the Office Action.

(4) Status of Application

A final Office Action was issued dated June 16, 2004.

(5) Summary of Invention

A. Background

Many times when a person reads a book there are at least several words in the book that the reader is unfamiliar with. Sometimes the meaning of these words can be gleaned by how the words are used in sentences. However, more often the reader needs to consult outside references, such as dictionaries, encyclopedias, etc. to gain an understanding of these words. Often these sources are not readily available and, thus, the reader may elect to forego such interruptions because they are time consuming and disruptive to the readers concentration.

Instead the reader may guess at the meaning of the word by its context in the sentence or paragraph. Incorrect guesses may lead to erroneous conclusions as to the meaning of the text that is being read. The frequency of misunderstanding by a reader increases with the complexity of the vocabulary used by the writer. Thus, it would be advantageous to a reader if the

meaning of difficult or unusual words were made conveniently and easily accessible.

B. Instant Invention

The present invention provides an apparatus for marking a page in a predetermined book. The apparatus comprises a substrate having a predetermined size and a predetermined configuration and selected words disposed adjacent definitions of the selected words on at least one side of the substrate, the selected words being words that are used in such predetermined book which are likely to be unfamiliar to an average reader of such book for which the apparatus is to be used.

(6) Issues

The first issue in the present application is whether claims 1-3, 7-9, 11, 13 and 14 are obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360.

The second issue is whether claims 4,5 and 16-20 are obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Renegar, US. Patent No. 6,024,571.

The third issue is whether claim 6 is obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Renegar, U.S. Patent No. 6,024,571 and further in view of Finkelstein et al., U.S. Patent No. 5,856,661.

The fourth issue is whether claim 10 is obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Batjuk, U.S. Patent No. 5,934,708.

The fifth issue is whether claim 12 is obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Marshall, U.S. Patent No. 6,474,992.

The sixth issue is whether claim 15 is obvious under 35 U.S.C 103(a) over Goodman, U.S. Patent No. 4,544,360, in view of Leon, U.S. Patent No. 5,414,946.

(7) Grouping of Claims

Claim 1 will stand or fall alone; claims 2-6 will stand or fall as a group; claims 7, 8, 9, 10 11 and 12 will stand or fall alone; claims 13 and 14 will stand or fall as a group; claim 15 will stand or fall alone; claims 16-20 will stand or fall as a group.

(8) Argument

A. The Prior Art

The prior art relied upon by the Examiner in rejecting claims 1-3, 7-9, 11, 13 and 14 as discussed above with respect to the first issue, was characterized by him as follows: "..... Goodman discloses in Figures 1 and 4 and in column 3, line 35 to column 4, line 25 an apparatus comprising a rectangular substrate

26 having a predetermined size and configuration, wherein information pertaining to a particular book is printed on the substrate. While Goodman does not explicitly disclose that definitions of words are provided on the substrate, Goodman does disclose that various types of information, including descriptions of characters and answers to questions, are provided. Words and definitions are very analogous to characters and their descriptions, and would have been an obvious variation to one of ordinary skill in the art for the purpose of providing a reference guide to selected words. The phrase 'for marking a page in a predetermined book' is functional language, which describes the intended purpose of the device rather than providing further structural limitation, and thus is not deemed to have patentable weight. The substrate of Goodman is physically capable of being used to mark a book. With respect to claims 2 and 3, while the material used to form the substrate is not explicitly disclosed, Official Notice is taken that it is well known to use paper for sheets such as that of the Goodman device. With respect to claim 7, Official Notice is taken that in providing definitions of words, it is well known too utilize synonyms. Such a feature would have been obvious for the purpose of enabling a user to easily and quickly determine the definition of a word. With respect to claim 9, while the size of the sheet is not explicitly disclosed, Official Notice is taken that

reference sheets are provided in many different sizes. The specific size claimed would have been an obvious variation. With respect to claim 11, Official Notice is taken that standard print is, well, standard for sheets containing printed matter. With respect to claim 13, the word key logo does not appear to have a specific function apart from trademarking or decorative purposes, and as such is an aesthetic choice of design. With respect to claim 14, Goodman discloses in Figure 4 that the Title of the book is provided on the substrate. Modification to include the author's name would have been obvious for the purpose of providing additional detail regarding the book."

The prior art relied upon by the Examiner in rejecting claims 4, 5 and 16-20 as discussed above with respect to the second issue, was characterized by the Examiner as follows: "Goodman discloses all of the limitations of claims 4 and 5 with the exception of the lamination. Providing lamination to printed matter including reference lists is well known, as disclosed for example in column 6, lines 15-18 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. With respect to claim 5, it is well known, when laminating an article, to use plastic. Goodman further discloses or suggests all of the limitations of claims 16-20 with the exception of the folding

creases. Providing folding creases to printed matter including reference lists is well known, as disclosed for example in Figures 4-9 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. At least 8 surfaces are shown in Figure 6 (the four shown, and the four on the rear side.)"

The prior art relied upon by the Examiner in rejecting claim 6 as discussed above with respect to the third issue, was characterized by the Examiner as follows:

"Goodman as viewed in combination with Renegar discloses all of the limitations of the claim with the exception of the magnifying feature. Finkleston discloses in column 5, lines 10-59 a laminated article comprising an integral magnifying lens. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman as viewed in combination with Renegar by providing a magnifying feature for the purpose making the substrate easier to read."

The prior art relied upon by the Examiner in rejecting claim 10 as discussed above with respect to the fourth issue, was characterized by the Examiner as follows:

"Goodman discloses all of the limitations of the claim with the exception of the bold print. Batjuk discloses in the Figure

an apparatus comprising a substrate having words and definitions, where the words are printed in boldface, and the definitions are provided in standard print. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing boldfaced words for the purpose of making them easier to distinguish from the definitions."

The prior art relied upon by the Examiner in rejecting claim 12 as discussed above with respect to the fifth issue, was characterized by the Examiner as follows:

"Goodman discloses all of the limitations of the claim with the exception of the words being in alphabetical order. Marshall discloses in Figure 1 an apparatus comprising a substrate for use with a book having letters and sounds, where the letters are provided in alphabetical order. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing words in alphabetical order for the purpose of making them easier to find on the substrate."

The prior art relied upon by the Examiner in rejecting claim 15 as discussed above with respect to the sixth issue, was characterized by the Examiner as follows:

"Goodman discloses all of the limitations of the claim with the exception of the magnifying slide. Leon discloses in Figure 1 and 6 and in column 2, lines 61-64 an apparatus comprising a substrate having printed matter thereon, further comprising a

magnifying slide 22. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a magnifying slide for the purpose of making the substrate easier to read."

B. Appellant's Arguments

With regard to the first issue, Goodman teaches, "According to the present invention in its broadest aspect, there is provided a reference list for use with a book, comprising a sheet having inscribed thereon information related to the contents of the book, which information is arranged in the same order as the corresponding parts of the book, and masking means overlying the information and adapted to be removed by the reader as required so as to provide a reference index in which only information relating to parts of the book already read is revealed." (Column 1, lines 45-54). (Underlining is for emphasis.)

The present invention provides a mini-dictionary in which difficult words found in the book are defined generally in the context of which the words are used in the book. The words are listed in alphabetical order and thus it is necessary for the apparatus to be open to the reader from the very beginning since the difficult words could occur anywhere in the book. There is no masking means overlying the information in the present invention.

Further, Goodman teaches "Referring now to the drawings, there is shown in FIGS. 1 to 3 a holder of a progressive index according to a first embodiment of the invention, consisting of a three-layer structure comprising a bottom layer 2, an intermediate layer 4 and a top layer 6. The three layers are made of relatively thin, transparent plastic material such as polyethylene, P.V.C. or the like. In the embodiment as illustrated the bottom layer 2 and the top layer 6 consist of a single, folded piece of material. However, the holder can be made of three separate pieces.

In manufacturing the holder, the first step consists of thermally "stitching" the intermediate layer 4 and the top layer 6 together by means of horizontal welding seams 8 that define the width of the thus produced pockets 10 into which fit slidably the masking strips 12 shown ghosted-in FIG. 1 and in FIG. 3, and the vertical seam 14 which delimits the depth of the pockets 10 so that even when the strips are inserted into the pockets 10 as far as they will go, i.e. right up to the seam 14, their free end 16 will slightly project beyond the edge 18 of the pocket 10 to facilitate manipulation.

As a final step, the bottom layer 2 is joined to the already joined intermediate and top layers 4 and 6. In the illustrated embodiment this is effected by two additional welding seams, a

vertical seam 20 and a horizontal seam 22 that also delimits the lowermost pocket 10.

If the bottom layer 2 and the top layer 6 are made of separate pieces, an additional horizontal seam 22 is of course required at the top edge of the holder. The seams 20 and 22 have now defined a compartment 24 into which slidably fits a sheet 26 on which there is printed the information relevant to the book, for example the list of characters appearing in the book." (Column 3, line 35 to Column 4, line 1).

The present invention has no pockets nor are there any "weldable" or "stitched" seams in the present invention as is taught by Goodman. The teaching of Goodman provides for a rather elaborate apparatus that is designed to provide answers to questions only in the order that they appear in the book. The present invention provides one sheet, which may be folded or can be used as a simple one page sheet, with words and definitions presented on at least one side of the sheet and which is available to the reader at any time. The size of the sheet is such that it can be used as a bookmark without being unwieldy and this also keeps the apparatus handy for use when needed.

The apparatus of Goodman provides for basically five layers of material. Three layers of plastic form the holder while there is a sheet of material inserted in the pocket and then there are

masking strips which cover the sheet with information on it that are to be removed as the book is read.

Further, Goodman teaches that (with reference to paperback books) "It is thus possible for a progressive reference list to be produced on the inside cover or covers of such books and become an integral part of it. Since the average paperback has some forty five lines of print, excluding headings, a list of twenty to twenty five lines could readily be printed on the inside cover or covers of such a book. If more than this number is required to be listed, both the front and back covers could be used." (Column 2, lines 38-45). (Underlining is for emphasis).

Thus, the teaching of Goodman is essentially teaching away from the use of such an apparatus as a bookmark.

The prior art of Goodman does not teach or even suggest an apparatus as that defined in the claims of the present invention. It is only in hindsight that the apparatus as taught by Goodman can be compared to the apparatus that is provided in the present invention. Therefore, Applicant respectfully requests the Board to reverse the Examiner's rejections of claims 1-3, 7-9, 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Goodman.

With regard to the second issue, Applicant does not understand why the Examiner feels that "it would be obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose

of enhancing the durability of the sheet". There is no need for lamination of the sheet in the Goodman apparatus since the apparatus as taught by Goodman is formed from a thin transparent material such as polyethylene and, thus, since the apparatus is encased in polyethylene laminating this apparatus would be a costly unnecessary step which would not provide any additional durability to the sheet since polyethylene is probably more durable than lamination.

Further, if the sheet itself, as taught by Goodman, were laminated it would be difficult to fit the laminated sheet into the pocket formed in the polyethylene holder. Again, this would be totally unnecessary since the sheet as taught by Goodman is protected by sheets of polyethylene.

Therefore, Applicant respectfully requests the Board to reverse the rejections of claims 4, 5 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar.

With regard to the third issue, Finkelston teaches "The subject invention is directed to a financial transaction card such as a credit card or the like which incorporates an integral magnifying lens. Use of the card of the subject invention automatically places a magnifying lens at the disposal of the user, whereby he may immediately verify a financial transaction at the point-of-sale without first locating a magnifying glass or taking the time and effort to put on reading glasses."

The magnifier of Finkelston is basically a magnifying lens placed in a credit card which the user may place over a sheet with sale information on it so as to be better able to read the numbers or the terms of an agreement. This is quite different than having magnification permanently in place in the plastic laminate which is covering the apparatus. In the present invention the magnification is there all the time and is part of the apparatus and is not moveable but is in the laminate covering the words and definitions so as to make them appear larger and easier to read by the user. The teaching of Finkelston would be no different than having a magnifying glass available instead of having the magnifier imbedded in a credit card.

Applicant has previously discussed the teaching of Goodman in view of the teaching of Renegar and since Finkelston does not teach a magnification means similar to that of the present invention, Applicant respectfully requests the Board to reverse the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar, and further in view of Finkleston.

With regard to the fourth issue, Applicant has discussed previously that Goodman neither teaches nor even suggests an apparatus as that claimed in the present invention. The teaching of Batjuk which provides for an alphabetic foreign language in which words are printed in boldface and the definitions in

standard print doesn't affect the fact that the present invention is different from that as taught by Goodman; therefore, Applicant respectfully requests the Board to reverse the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Batjuk.

With regard to the fifth issue, Marshall discloses in Figure 1 and Figure 2B words that are not in alphabetical order. The items in Figure 2A, which the Examiner referred to as Figure 1, are the common vowels and they are normally put in the order of a, e, i, o and u. Marshall also lists the word consonants further down on the sheet after he had listed the word(s) short vowels and c is alphabetically earlier in the alphabet than s. This does indicate that Marshall is not necessarily teaching words being placed in alphabetical order. Marshall is teaching sounds or word pronunciations and not definitions. Further, Goodman teaches information bearing lines that are masked initially and are progressively unmasked as the book is read. It would not be feasible for items in an alphabetical order to be masked and unmasked as the book is read. As stated previously the present invention provides difficult words with their definitions that are always in view of the reader since the words may occur anywhere in the book.

Since it was previously discussed that Goodman does not teach the present invention and the addition of Marshall does not


alter the difference between Goodman and the present invention, Applicant respectfully requests the Board to reverse the rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Marshall.

With regard to the sixth issue, the present invention provides a magnifying slide that is affixed to the substrate. The substrate is where the words and definitions of the present invention are displayed. The magnifier can slide up or down the substrate so as to magnify the word which is reader is concerned about. In the invention of Goodman the information is disposed on a sheet which is encased in a pocket formed between two layers of polyethylene. It would be difficult to provide a magnifier which could slide over the sheet with information as taught by Goodman when the sheet is in a pocket and which further is covered by masking strips which are uncovered individually. Therefore, Applicant respectfully requests the Board to reverse the rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Leon.

Applicant makes note of the fact that it required 6 different prior art references for the Examiner to reject the claims of the present invention which would indicate that the

invention is not really obvious with regard to the referenced prior art.

Respectfully submitted,
James Ray and Associates

By 
Amos Bartoli
Registration No. 42,299
Agent for Applicant

JAMES RAY & ASSOCIATES
2640 Pitcairn Road
Monroeville, PA 15146
Tel. (412) 380-0725
Fax (412) 380-0748

9) APPENDIX

The claims on appeal are as follows:

1. An apparatus for marking a page in a predetermined book, said apparatus comprising;

(a) a substrate having a predetermined size and a predetermined configuration; and

(b) selected words disposed adjacent definitions of said selected words on at least one side of said substrate, said selected words being words that are used in such predetermined book which would likely require a reader of such book to go to a dictionary to find a meaning for such words.

2. An apparatus, according to claim 1, wherein said substrate is made of one of plastic, cardboard, paper and various combinations thereof.

3. An apparatus, according to claim 2, wherein said substrate is paper.

4. An apparatus, according to claim 3, wherein said paper is laminated paper.

5. An apparatus, according to claim 3, wherein said paper is laminated in plastic.

6. An apparatus, according to claim 5, wherein said plastic laminated paper is further modified to include magnification in said plastic laminate.

7. An apparatus, according to claim 1, wherein said definitions of said words includes appropriate synonyms.

8. An apparatus, according to claim 1, wherein said predetermined configuration is generally rectangular.

9. An apparatus, according to claim 1, wherein said predetermined size is substantially about 4¼ by 8½ inches.

10. An apparatus, according to claim 1, wherein said selected words are printed in bold print.

11. An apparatus, according to claim 1, wherein said definitions of said selected words are printed in standard print.

12. An apparatus, according to claim 1, wherein said selected words are arranged in an alphabetical order.

13. An apparatus, according to claim 1, wherein said apparatus further includes a word key logo disposed on a first side of said at least one side of said substrate.

14. An apparatus, according to claim 13, wherein said apparatus further includes a title and an author of such predetermined book disposed beneath said word key logo.

15. An apparatus, according to claim 1, wherein said apparatus further includes a magnifying slide affixed to said substrate.

16. An apparatus, according to claim 1, wherein said apparatus further includes at least one crease to enable said substrate to be folded at least once so as to provide a plurality of surfaces.

17. An apparatus, according to claim 16, wherein said plurality of surfaces is four.

18. An apparatus, according to claim 16, wherein said plurality of surfaces is six.

19. An apparatus, according to claim 16, wherein said plurality of surfaces is eight.

20. An apparatus, according to claim 16, wherein said substrate after being folded at least once is substantially about $4\frac{1}{4}$ by $8\frac{1}{2}$ inches.